

REMARKS

Applicants respectfully request reconsideration and allowance of their reissue application.

New claim 55 is presented with underlining pursuant to 37 CFR 1.173(d). It is supported by the specification at column 4.

Claim 41 has been canceled without prejudice.

Consent of Assignee and 37 C.F.R. § 3.73(b) Statement

The requested document will be filed with the Examiner to satisfy the December 4, 2001 Office Action, page 7, last paragraph. The Assignee has consented as seen from the Power of Attorney herein.

37 C.F.R. § 1.178: The Original Patent Grant Was Already Surrendered

The Examiner repeats a requirement to surrender the original patent grant. This is not understood. The Assignee has already surrendered the original grant, as will be evident from the paper dated November 6, 2000 in the parent reissue. The original patent grant cannot be re-surrendered.

The New Matter Rejection Should be Promptly Withdrawn

The December 4, 2001 Office Action presented a new matter rejection at pages 6 and 7 as to claims 22-54. It is respectfully requested that the new matter rejection be withdrawn.

All claims are supported in the original specification. The original specification contains a written description of the invention whereby those skilled in the art would recognize that Applicant(s) were then in possession of the claimed invention, as is consistent with 35 U.S.C. § 112 (¶1). The amounts recited are disclosed via the relative ratios, as would be understood by those skilled in the art. This is clearly seen from the original patent claims, including claim 13, now reconfirmed valid in the parent reissue patent grant.

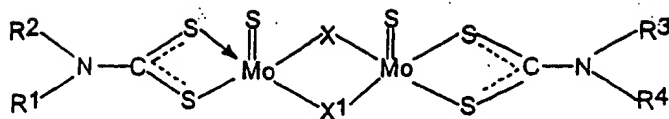
Claim 54 defines the product, i.e., lubricated object, attained per claim 53. The latter claim is fully supported in the original specification and so too is claim 54. There is no statutory requirement for 35 U.S.C. § 112 (¶1) for exact, literal correspondence between words in a claim and the specification.. “[T]he subject matter of a later claim need not be described literally or “*in ipso verbis*” in order for the specification to satisfy the written description requirement.” Sokal et al, Chemical Patent Practice, Chapter 6, page 6-88 (PRG 1996); see also, Union Oil Co. of California v. Atlantic Richfield Co., 54 USPQ 2d 1227, 1234-36 (Fed. Cir. 2000), copy attached.

Art Teaches Active Sulfur

The references of record suggest that the art was using or teaching sulfur-containing compounds. Indeed, as will be explained more fully below, art now of record suggests that those skilled in the art would have had a further motivation towards the active sulfur compounds because of “synergy.” These teachings individually and collectively *teach away* from the present claimed inventions.

For instance, U.S. Patent No. 4,330,420 of White was shown to the Examiner during the personal interview in the parent reissue application. A copy is attached hereto. In the White reference, about 0.2 to 4.0 weight percent of sulfurized polyolefin antioxidant in combination with certain specified ingredients is disclosed. This reference teaches those skilled in the art to use formulation and additive packages “containing synergistic amounts of sulfurized polyolefin antioxidants ...” (emphasis added). The White reference further states that in “some oxidation stability cannot be achieved by merely adding more biphenyl amine.”

It was pointed out in the parent reissue application that the PCT International Application WO 95/07963 to Shaub was published on March 23, 1995, only eight months before the filing date for the original patent application herein. It is a contemporaneous publication and was of record during patent prosecution of the original patent grant. The Shaub reference clearly teaches the ordinary skilled artisan to use active sulfur-containing compounds of general formula 1:



wherein R^1 , R^2 , R^3 , and R^4 , may be the same or different, and each represents a C_7 to C_{24} hydrocarbyl radical, X and X^1 may be same or different and independently represent S or O, and the molybdenum cation is in an oxidation state of 5+ or less. No matter what X or X^1 is, the molybdenum cation is bonded at least thrice to sulfur atoms, which are not in the highest oxidation state. This reference therefore teaches the use of active sulfur, which is the antithesis of the present claimed inventions.

The Shaub reference refers to Molyvan® 822 product at page 4. According to the Shaub reference, the Molyvan® 822 brand product contains active sulfur.

It is noted that the April 1986 Technical Data Sheets for the Molyvan® 822 brand product (see June 19, 2000 Supplemental Disclosure Statement in the parent reissue) states "MOLYVAN 822 is a unique molybdenum-sulfur combination in an oil-soluble form." The Molyvan® 822 technical data sheets teach away from the present invention.

Also, the Technical Bulletin 941 disclosed by applicant also refers to the Molyvan® 822 product as having an unknown proprietary formula. The undisclosed proprietary formula would have led away from the reissue claims as there is no suggestion of being sulfur free in the Technical Bulletin.

The cited de Vries et al. reference actually teaches away from the reissue claims. The de Vries et al. reference teaches antioxidant combinations of sulfur containing molybdenum complexes. See de Vries et al., Title to U.S. Patent No. 4,394,279. The de Vries Abstract refers to "a sulfur containing molybdenum compound." The de Vries et al. reference further discloses combining "(a) sulfur containing molybdenum compound ..." with "(b) an aromatic amine compound." See de Vries et al., column 1, lines 47-52. References to sulfur-containing molybdenum complex (or compound) elsewhere pervade the de Vries et al. reference. See, e.g., de Vries et al., column 1, lines 55-66; column 2, lines 1-3; column 2, lines 15-42; column 5, lines 41-46; column 8, lines 15-19; column 8, line 65 - column 9, line 23 (Example 1, 1.36%) sulfur column 9, line 24 to column 9, line 9 (Example 2, 3.75% sulfur); column 9, line 50 to column 10, line 5 (Example 3); column 10, lines 6-48 (reporting the use and testing of the sulfur-containing molybdenum complexes per Examples 1-3). The de Vries et al. reference uses carbon disulfide in the preparation of its required sulfur

containing compounds and the disulfide means the sulfur is divalent - active sulfur - which teaches away from the present reissue claims.

Another reference discloses the use of a two-component system including a dithiocarbamate functional group, a phosphate functional group and a copper compound. See, e.g., Thorsell et al., U.S. Patent No. 4,648,985, at column 6, lines 49-52. The copper compound teaches away from the present invention. The copper dithio carbamates disclosed in the Thorsell et al. reference include active sulfur and thus teach away from the present claimed inventions.

The Office Action Erroneously Asserts An Admission

The Examiner relies on an alleged admission. There is no such admission in the specification. There is no admission of motivation in the manner alleged in the Office Action. Applicant(s) respectfully submit that the Examiner has impermissibly used their own teachings against them. The PTO must adhere to the rulings of its reviewing court. The reviewing court is the Federal Circuit and it has stated:

“To draw on hindsight knowledge of the patented invention, when the prior art does not contain or suggest that knowledge, is to use the invention as a template for its own reconstruction – an illogical and inappropriate process by which to determine patentability.”

Sensorics, Inc. v. Aerosonic, 81 F.3d 1566 (Fed. Cir. 1996). That is precisely what has happened in the present case. There are no cited prior art patents or references to support a critical element to the rejection. Instead, the Office Action cites Applicants' own specification against them in contravention of well-established precedent from the Federal Circuit.

The Claimed Inventions Would Have Been Unobvious

Claims 22-40 and 42-54 define unobvious inventions over the improper combination of the Thorsell reference, the above-vitiated alleged admission, and the DeVries reference.

The rejection actually is evidence of unobviousness, not the converse. The Thorsell reference teaches away from the claimed inventions. It teaches copper dithiocarbamate. The DeVries reference also teaches away from the claimed inventions. It teaches sulfur-containing complexes. The Applicants made no admission of prior art in their specification, and merely including written description of *their* invention legally and factually cannot amount to an admission of prior art teaching to vitiate the sulfur teachings in each of the Thorsell and DeVries references.

Stated another way, the record is otherwise lacking facts to support the rejection. In re Lee, Appeal No. 00-1158 (Fed. Cir. Jan. 18, 2002). In the Lee case, the Federal Circuit vacated a USPTO decision that patent applicant Lee's invention would have been obvious. The invention is a method for automatically displaying the functions of a video display device and demonstrating how to select and adjust the functions. The USPTO cited two prior art references but did not explain the evidence that would lead one skilled in the art to combine the references to obtain Lee's invention. The Federal Circuit said case law and the Administrative Procedure Act require the agency to make findings of fact and present its reasoning in sufficient detail to allow the court to conduct meaningful review.

Now as to claim 41, it is a dependent claim and would have been unobvious to a person of ordinary skill in the art over the Thorsell and De Vries references for the reasons stated above. Adding the Hunt reference would not have made-up for the short-comings in the art applied to claims 22-40 and 42-54. There is still no affirmative prior art teaching to eviscerate the Thorsell and De Vries references before reconstructing the present claimed inventions.

Before concluding, Applicants respectfully direct the Examiner's attention to the point that the prior art taught away from the claimed inventions. The Examiner's attention is directed to U.S. Patent No. 4,765,918 to Love et al. The Love et al. patent issued in 1988 which is approximately contemporaneous with the Hunt reference (1989). The Love et al. reference teaches a sulfur-containing reaction product. It would have taught against the rejection of claims 22-40 and 42-54 and taught against the rejection of claim 41. A copy of the Love et al. reference is attached hereto.

Conclusion

Claims 22-40, 42-54 and 55 are in condition for allowance and notice of same is requested. The claims define unobvious subject matter and are supported by the specification.

If the Examiner has any questions, please contact the undersigned.

Notice to the above effect is earnestly solicited.

Respectfully submitted,

FITCH, EVEN, TABIN & FLANNERY

By: _____

Kendrew H. Colton
Registration No. 30,368

Fitch, Even, Tabin & Flannery
1801 K Street, N.W.
Suite 401L
Washington, D.C. 20006-1201
Telephone No. (202) 419-7000
Facsimile No. (202) 419-7007

APPENDIX

Claim 41 has been cancelled.

New claim 55 has been added.